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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,745	02/12/2004	Gregory A. Griffin	D5260	5613
30409	7590	12/02/2005	EXAMINER	
INTERNATIONAL ENGINE INTELLECTUAL PROPERTY COMPANY			PATEL, VISHAL A	
4201 WINFIELD ROAD			ART UNIT	
P.O. BOX 1488			PAPER NUMBER	
WARRENVILLE, IL 60555			3673	

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/777,745

Applicant(s)

GRIFFIN ET AL.

Examiner

Vishal Patel

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4, 6-7 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Inciong (Us. 6,543,787).

Inciong discloses a gasket comprising a metal substrate disposed along an outer perimeter of the gasket. There is an elastomeric bead (32) disposed along at least an interior perimeter of the metal substrate. There is an elastomeric ring (32, around 22 that is in the form of a ring) disposed along the metal substrate having an inner diameter. The elastomeric ring and the elastomeric bead are formed of a continuous rubber material that is formed on the metal substrate.

As pointed out in the office action that applicant has not claimed the fasteners that relate to the limitations that the inner diameter is smaller than an outer diameter of a fastener, hence this limitations are not given patentable weight.

Regarding to claims 6-7 and 19: The gasket is capable of retaining a fastener and be between an engine cover and an oil pick-up tube attached to the flange.

Furthermore limitations that the inner diameter forms an interference fit with the fastener is not given patentable weight because the fastener is not positively claimed.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Belter (US. 5,618,047) in view of Inciong.

Belter discloses a gasket having a metal substrate disposed along an outer perimeter of the gasket, an elastomeric bead disposed along an interior perimeter of the metal substrate and a plurality of teeth (44) disposed along an outer perimeter of the elastomeric bead corresponding with a plurality of groove (figure 6) disposed along at least a section of the interior perimeter of the metal substrate.

With regard to the ring having the inner diameter smaller than an outer diameter of a fastener. Applicant has not positively claimed the fastener and therefore the limitation is not given patentable weight.

The limitation that the elastomer is injection molded is not given patentable weight because this is a process limitation within a product claim.

Belter discloses substantially the same seal as applicant except for an elastomeric ring disposed along fastener holes on the metal substrate. Inciong discloses an elastomeric ring (portion of 32 that forms a ring around bolt holes 20) disposed along fastener holes along the metal substrate in order to provide sealing around a fastener and depression in the metal substrate. It would have been obvious to one having ordinary skill in the art at the time the

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invention was made to modify the Belter gasket as taught by Inciong in order to provide sealing around a fastener.

Response to Arguments

5. Applicant's arguments filed 7/11/05 have been fully considered but they are not persuasive.

6. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., smaller than an outside diameter of a fastener) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore if a fastener is to be sealed than the diameter would be less than an outside diameter of the fastener.

Evidence is showed by Fucci et al and Mockenhaupt that to have a diameter of a ring is well know to one skilled in the art and would provide retention of a fastener.

Applicants' argument that Inciong does not teach an elastomeric ring around an aperture is not persuasive because as seen in figure 5 that fastener holes 20 are surrounded by an elastomeric ring.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishal Patel whose telephone number is 571-272-7060. The examiner can normally be reached on 6:30am to 8:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather C. Shackelford can be reached on 571-272-7049. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VP
November 23, 2005

A handwritten signature in black ink, appearing to read 'Vishal Patel', with a stylized flourish at the end.

Vishal Patel
Patent Examiner
Tech. Center 3600